Supreme Court, U. S.
FILED
SEP 1 1979
MICHAEL RODAK, JR., CLERK

IN THE

# Supreme Court of the United States

October Term, 1979
No. 78-1901

ARTHUR M. HERSCHENSOHN and CORONA HAIR NET CORP.,

*Petitioners,*

*vs.*

ROBERT M. HOFFMAN, HOFFMAN BEAUTY AND BARBER SUPPLY CO., and ADVANCE DESIGN LABORATORIES, INC.,

*Respondents.*

**Opposition to Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.**

R. DOUGLAS LYON,
A Member of LYON & LYON,
800 Wilshire Boulevard, Suite 900,
Los Angeles, Calif. 90017,
(213) 489-1600,
*Counsel for Respondents.*

September 1979

Parker & Son, Inc., Law Printers, Los Angeles. Phone 724-6622

## SUBJECT INDEX


I.

Page

Statement of the Case ..... 1

A. The Patent in Suit ..... 1

B. The District Court Opinion ..... 2

C. Opinion of the Court of Appeals ..... 3

II.

Argument ..... 4

Conclusion ..... 6

## TABLE OF AUTHORITIES CITED


| Cases | Page |
|---|---|
| Anderson's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 90 S.Ct. 305, 24 L.Ed.2d 258 (1969) | 4, 5 |
| Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) | 4, 5 |
| Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 71 S.Ct. 127, 95 L.Ed. 162 (1950) | 2, 4, 5 |
| Republic Industries Inc. v. Schlage, 592 F.2d 963, 200 USPQ 769 (7th Cir. 1979) | 5 |
| Sakraida v. Ag Pro, Inc., 425 U.S. 273, 96 S.Ct. 1532, 47 L.Ed.2d 784, 44 U.S.L.W. 4477 (1976) | 4, 5 |
| **Rules** | |
| Federal Rules of Civil Procedure, Rule 52(a) | 4, 5 |
| **Statute** | |
| United States Code, Sec. 103 | 3 |


IN THE

# Supreme Court of the United States

October Term, 1979
No. 78-1901

ARTHUR M. HERSCHENSOHN and CORONA HAIR NET CORP.,

*Petitioners,*

*vs.*

ROBERT M. HOFFMAN, HOFFMAN BEAUTY AND BARBER SUPPLY CO., and ADVANCE DESIGN LABORATORIES, INC.,

*Respondents.*

**Opposition to Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.**

## I.
## STATEMENT OF THE CASE.

### A. The Patent in Suit.

The patent involved in this litigation involves the simplest form of structure, a hair brush combining four (4) elements fully disclosed by the prior art; a handle, a flexible spine, laterally extended fingers and tufts of relatively stiff bristles. The patentee conceded the elements individually were old as clearly recognized by the District and Appellate Courts. Consequently, the questions are the validity of such a combination patent, and if same was infringed. The patent lists various purposes and objects: (1) mechanical action

to penetrate thick tresses, dig into the scalp and cause drag on the hair and scalp to accomplish the effects of massage; (2) to agitate the root of the hair and its associated muscle tissue and bring additional sebum to the air and increase the luster of the hair; (3) to automatically pinch and tug the hair and thus exercise the hair roots and their environments; (4) to provide a brush which is easily cleanable, simple in construction, reasonable in cost, and efficient in carrying out the purposes for which it was designed; (5) finally, since the tips of the fingers in the patent all come towards each other, causing the bristle tufts to pinch the hair between them, the bristles are generally of stiff material. The attendant movement of the brush will cause the pinched hair to be tugged, dragged on and pulled.

**B. The District Court Opinion.**

The trial court was trying its first patent case and, apparently, was influenced by matters not really germane to the issues of validity and infringement. Its Opinion reflects reliance upon a comparison of the accused structure with the patentee's commercial structure, not the Claims of the patent, with the fact that copying occurred and substantial sales of the patentee's structure has occurred. While lip service was given to the patent and its Claims, no real disposition of the issues presented thereby occurred. Thus, in an effort to comply with tests set forth in *Great A & P v. Supermarket Equipment Corp.*, 340 U.S. 147 (1950), the Court concluded that a new and unexpected result occurred, "The flexibility of the brush's spine element when coupled with the vents allows the brush to be pulled through the hair with remarkable ease." This was



carried into Finding of Fact 22, and is the exact opposite of the teaching of the patent as set forth in objects 1-5 stated above. The trial court's Memorandum of Decision substantially ignores the language of the Claims and any attempt to apply same to the accused structure despite the uncontrovertible evidence that the accused device lacked the elements of the Claims as follows: (1) "Comprising a flexible spine element extending from the handle" in the accused device, the spine is rigid and will not and cannot flex during normal use; (2) "said spine will bend so that the distal ends of the fingers on the trailing side of the brush will approach each other", an impossibility in the accused structure during normal use; (3) "tufts of stiff bristles", the accused structure uses a single filament.

The trial court adopted without change the Findings and Conclusions submitted by the Patentee and specifically refused to make findings that the accused structure included elements (1), (2) and (3) above when requested to by Defendant, presumably recognizing there was no evidence to support same.

**C. Opinion of the Court of Appeals.**

The Appellate Court made an analysis of the teaching of the patent in suit and its objects, carefully set forth the criteria established by this Court in the interpretation and application of 35 U.S.C. §103 and concluded that the patent was invalid as obvious to a person having ordinary skill in the art. The advance over the prior art urged by the Patentee was (1) allowing the brush to be pulled through the hair with remarkable ease, and (2) the vents allowing the hair to be easily blown dry. The Appellate Court

concluded that this was the opposite of the teaching of the patent and further did not constitute a new or unusual result under *Great A & P v. Supermarket*, 340 U.S. 147 (1950). *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969) and *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976). Further, the Court reviewed and applied the test forth in *Graham v. John Deere*, 383 U.S. 1 (1966) and found the combination claims invalid. Each element was old in the art and the combination thereof was obvious and produced nothing that would raise this above the ordinary skill of the art and to the status of inventive.

On the issue of infringement, the Appellate Court properly tested the accused structure against the claim language and found the latter inapplicable. The accused structure lacks the three (3) elements of (1) a flexible spine; (2) which would bend so that the distal ends of the fingers on the trailing side of the brush will approach each other; (3) tufts of stiff bristles. The Opinion points out the failure of the trial court to make proper findings on these issues and indeed its refusal to do so. The Court went out of its way to point out the findings made by the trial court were clearly erroneous, and contrary to all of the evidence at the trial. While the Court did not specifically refer to Rule 52(a) Federal Rules of Civil Procedure, it is readily apparent that it carefully and meticulously applied its standard.

## II.
## ARGUMENT.

While Petitioner seeks to establish a conflict between the Circuits as to the meaning and application of this Court's *Anderson's-Black Rock v. Pavement Salvage Co.*, 396 U.S. 57 (1969) and *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976), it is submitted that the present case does not present the issue for disposition. Without conceding that any conflict does in fact exist, the *dicta* in the *Republic Industries, Inc. v. Schlage*, 592 F.2d 963 (1979) clearly indicates such conflict may evolve in a proper case and final resolution of same would appear desirable. The present case does not seem to be the proper vehicle. The Appellate Court here held the patent invalid because that which the trial court relied upon as inventive was the direct opposite of the teaching of the patent and the subject of its claims. Stated differently, the trial court sought to sustain validity by wholly rejecting and ignoring that which the patent taught as its invention and relied upon the exact opposite. Thus, the validity issue was disposed of on a ground not involving the alleged conflict in the Circuits and consequently, the Decision of the Appellate Court may readily be affirmed without reaching the question of whether a "new and unexpected result" as used in *Great A & P v. Supermarket, supra* is the same or different from "synergistic result" as this terminology is used in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., supra*, and *Sakraida v. Ag Pro, supra*. Further, the question of whether these cases conflict with, modify or add an additional requirement to tests set forth in *Graham v. John Deere, supra* in all probability, need never be reached in this case. Further, despite the Patentee's protestations to the contrary, the Appellate Court in reversing on the issue of infringement inherently determined the trial court's findings to be clearly erroneous. It is clear the court was applying the standard of Rule 52(a) Federal Rules of Civil Procedure and

properly so where the trial court refused to make necessary specific findings to sustain a conclusion of infringement and tried to rely upon general conclusions in place thereof. Thus, this case can and should be disposed of on the issue of non-infringement never reaching the issue raised by the asserted conflict.

**Conclusion.**

This has been a long and expensive litigation imposing a heavy burden on the accused infringer. As determined by the Court of Appeals, the patent in suit is neither valid or infringed. Assuming a conflict may exist in the Circuits, this case does not involve same, nor depend upon same for its resolution. If the Court does determine that it should again review the test for patentable invention, this action is not the proper vehicle, as it can and should be disposed of before any such determination is reached.

Dated: August 31, 1979.

Respectfully submitted,

R. DOUGLAS LYON,
A Member of LYON & LYON,
*Attorneys for Respondents.*